



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,953	08/20/2003	Takeshi Nishino	122.1565	4976

21171 7590 11/30/2005

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

DESIR, PIERRE LOUIS

ART UNIT PAPER NUMBER

2681

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/643,953	Applicant(s) NISHINO ET AL.	
	Examiner Pierre-Louis Desir	Art Unit 2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,9,10,17,19,20 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,9,10,17,19,20 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 09/06/2005 have been fully considered but they are not persuasive.

Applicant argues that Nishimoto fails to disclose several features of the device as claimed in amended claim 1. In particular, Nishimoto does not disclose a pointing device that can be operated to move an operational object on a display screen in any 360-degree direction, nor does Nishimoto disclose changing an operation mode of the pointing device according to contents displayed on the display screen at the time the pointing device is operated. Furthermore, adds applicant, Nishimoto does not disclose a control unit that determines a direction in which the operational object can be moved on the display screen according to the operational mode.

Examiner respectfully disagrees with Applicant's assertions.

In response to applicant's arguments, the recitation "a pointing device that can be operated to move an operational object on a display screen in any 360-degree direction" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Also, Nishimura discloses that the pointer can be set to a desired piece of information by inherently moving the pointer in the direction of that piece information (paragraph 14).

Regarding Applicant's argument regarding Nishimura not disclosing changing an operation mode of the pointing device according to contents displayed on the display screen at the time the pointing device is operated, and not disclosing a control unit that determines a direction in which the operational object can be moved on the display screen according to the operational mode, Examiner respectfully disagrees.

Nishimoto discloses that the finger is shifted while it is in contact with the sensor window so as to set the pointer to a desired menu among menus displayed on the LCD. An optical image of the finger, detected by the image sensor, is transmitted to the CPU through an image sensor interface so that, for example, the shifting direction and the shift distance of finger 30 are found. Based upon the shifting direction and the shift distance of the finger thus found, the CPU shifts the pointer displayed on the LCD through the LCD interface. A proper input key is pressed with the pointer indicating the necessary information to select the corresponding information. Thus, the information is displayed on the LCD (see paragraphs 52-53). According to the menu displayed on the LCD, when the device is operated, the operational mode of the pointing device is changing relative to the finding of the shifting direction (i.e., determination of the direction in which the operational object (cursor or pointer) can be moved) and the shift distance of the finger (direction of which the pointing device can be operated).

Regarding claim 5, Applicant argues that Kim does not disclose nor suggest a device that provides a moving amount adjustment means for moving the operational object by a predetermined step value when the pointing device is operated.

Examiner respectfully disagrees with Applicant. Kim discloses an on-screen pointer speed controller for controlling the speed of movement of the on-screen pointer between icons,

according to a predetermined control signal (see col. 1, line 67 to col. 2, line 9). Thus, the on-screen pointer speed controller inherently adjusts the movement of the pointer by controlling the speed of movement of the on-screen pointer between icons.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 17, 20, 23, 25, 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishimoto, Pub. No. US 2002/0155857.

Regarding claim 1, Nishimoto discloses a pointing device that can be operated to move an operational object on a display screen in any 360-degree direction (i.e., the pointer can be set to a desired piece of information by inherently moving the pointer in the direction of that piece of information) (see abstract, and paragraph 14), comprising: a control unit for changing an operation mode of said pointing device according to contents displayed on said display screen at the time the pointing device is operated, wherein the control unit determines a direction in which the operational object can be moved on the display screen according to the operation mode, and defines the direction in which the operational object can be moved on the display screen, as a current direction which the pointing device can be operated (i.e., the finger is shifted while it is in contact with the sensor window so as to set the pointer to a desired menu among menus

displayed on the LCD. An optical image of the finger, detected by the image sensor, is transmitted to the CPU through an image sensor interface so that, for example, the shifting direction and the shift distance of finger 30 are found. Based upon the shifting direction and the shift distance of the finger thus found, the CPU shifts the pointer displayed on the LCD through the LCD interface. A proper input key is pressed with the pointer indicating the necessary information to select the corresponding information. Thus, the information is displayed on the LCD. According to the menu displayed on the LCD, when the device is operated, the operational mode of the pointing device is changing relative to the finding of the shifting direction (i.e., determination of the direction in which the operational object (cursor or pointer) can be moved) and the shift distance of the finger (direction of which the pointing device can be operated)) (see page 1, paragraphs 9, 52-53).

Regarding claim 17, Nishimoto discloses a mobile telephone comprising a pointing device (see claim 1 rejection, and abstract).

Regarding claim 20, Nishimoto discloses a mobile telephone (see claim 17 rejection) wherein said control unit is constituted in a main control unit of said mobile telephone (i.e., CPU) (see fig. 3).

Regarding claim 23, Nishimoto discloses a method for controlling a pointing device, that can be operated to move an operational object on a display screen in any 360-degree direction (i.e., the pointer can be set to a desired piece of information by inherently moving the pointer in the direction of that piece information) (see abstract, and paragraph 14) comprising the controlling step of: changing an operational mode of said pointing device according to contents displayed on said display screen at the time the pointing device is operated, wherein the control

Art Unit: 2681

unit determines a direction in which the operational object can be moved on the display screen according to the operation mode, and defines the direction in which the operational object can be moved on the display screen, as a current direction which the pointing device can be operated (see page 1, paragraphs 9, 52-53, and refer to claim 1 reasoning).

Regarding claim 25, Nishimoto discloses a mobile telephone (i.e., mobile terminal) (see abstract) comprising a pointing device that can be operated to move an operational object on a display screen in any 360-degree direction (i.e., the pointer can be set to a desired piece of information by inherently moving the pointer in the direction of that piece information) (see abstract, and paragraph 14), a control unit for changing an operational mode of said pointing device according to contents displayed on said display screen at the time the pointing device is operated, wherein the control unit determines a direction in which the operational object can be moved on the display screen according to the operation mode, and defines the direction in which the operational object can be moved on the display screen, as a current direction which the pointing device can be operated (see page 1, paragraphs 9, 52-53, and refer to claim 1 reasoning).

Regarding claim 29, Nishimoto discloses a mobile telephone (see claim 25 rejection) wherein the control unit is constituted in a main control unit of the mobile telephone i.e., CPU) (see figs. 3, 6, 9, 10, 17).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2681

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 9, 10, 19, 22, 24, 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimoto in view of Kim, U.S. Patent No. 6765598.

Regarding claims 5 and 26, Nishimoto discloses a pointing device and a mobile telephone as described above (see claims 1 and 25 rejections).

Although Nishimoto discloses a pointing device and a mobile telephone as described, Nishimoto does not specifically disclose a pointing device and a telephone wherein said control unit has moving amount adjusting means for moving said operational object by a predetermined step value when said pointing device is operated.

However, Kim discloses a device (see abstract) wherein the speed of movement of the movable pointer can be adjusted as a function of whether the variation in the X coordinate values is greater than or less than the variation in the Y coordinate values (see col. 5, line 66 through col. 6, line 2). Furthermore, Kim discloses an on-screen pointer speed controller for controlling the speed of movement of the on-screen pointer between icons, according to a predetermined control signal (see col. 1, line 67 to col. 2, line 9). Thus, the on-screen pointer speed controller inherently adjusts the movement of the pointer by controlling the speed of movement of the on-screen pointer between icons.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the characteristics of the device as described by Kim with the characteristics of the Nishimoto's device to arrive at the claimed invention. A motivation for doing so would have been to ensure the proper calibration of the pointer.

Regarding claims 9 and 27, Nishimoto discloses a pointing device as described above (see claims 5 and 26 rejection).

Although Nishimoto discloses a pointing device and a telephone as described, Nishimoto does not specifically disclose a pointing device and a telephone wherein said moving amount adjusting means move said operational object by the predetermined step value when the amount of operation of said pointing device takes the maximum value.

However, Kim discloses a device (see abstract) wherein the speed of movement of the movable pointer can be adjusted (see col. 5, line 66 through col. 6, line 2) wherein the moving the movable pointer at a first speed when the variation in the Y coordinate values is greater than the variation in the X coordinate values (see col. 6, lines 5-8); and the moving the movable pointer at a second speed when the variation in the X coordinate values is greater than the variation in the Y coordinate values, and wherein the second speed is faster than the first speed (see col. 6, lines 9-13. Also refer to col. 1, line 67 to col. 2, line 19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the characteristics of the device as described by Kim with the characteristics of the Nishimoto's device to arrive at the claimed invention. A motivation for doing so would have been to ensure the proper calibration of the pointer.

Regarding claims 10 and 28, Nishimoto discloses a pointing device as described above (see claims 5 and 27 rejection).

Although Nishimoto discloses a pointing device and mobile telephone as described, Nishimoto does not specifically disclose a pointing device and mobile telephone wherein said

Art Unit: 2681

moving amount adjusting means move said operational object by the predetermined step value when the amount of operation of said pointing device exceeds a predetermined threshold value.

However, Kim discloses a device (see abstract) wherein the speed of movement of the movable pointer can be adjusted (see col. 5, line 66 through col. 6, line 2) wherein the moving the movable pointer at a first speed when the variation in the Y coordinate values is greater than the variation in the X coordinate values (see col. 6, lines 5-8); and the moving the movable pointer at a second speed when the variation in the X coordinate values is greater than the variation in the Y coordinate values, and wherein the second speed is faster than the first speed (see col. 6, lines 9-13. Also refer to col. 1, line 67 to col. 2, line 19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the characteristics of the device as described by Kim with the characteristics of the Nishimoto's device to arrive at the claimed invention. A motivation for doing so would have been to ensure the proper calibration of the pointer.

Regarding claim 19, Nishimoto discloses a mobile telephone comprising a pointing device (see claim 5 rejection, and abstract).

Regarding claim 22, Nishimoto discloses a mobile telephone (see claim 19 rejection) wherein said control unit is constituted in a main control unit of said mobile telephone (i.e., CPU) (see fig. 3).

Regarding claim 24, Nishimoto discloses a method as described above (see claim 23 rejection).

Although Nishimoto discloses a method as described above, Nishimoto fails to specifically disclose a method wherein the pointing device can be operated to move said

Art Unit: 2681

operational object at any speed, and wherein said controlling step has the moving amount adjusting step of moving said operational object by a predetermined step value when said pointing device is operated.

However, Kim discloses a method for controlling a pointing device (see abstract) wherein the pointing device can be operated to move the operational object at any speed (i.e., the on-screen pointer speed controller controls the on-screen pointer to move between icons of different levels at a speed faster than an initially-set movement speed) (see col. 4, lines 49-51), and wherein said controlling step has the moving amount adjusting step of moving said operational object by a predetermined step value when said pointing device is operated (i.e., the speed of movement of the movable pointer can be adjusted as a function of whether the variation in the X coordinate values is greater than or less than the variation in the Y coordinate values) (see col. 5, line 66 through col. 6, line 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the characteristics of the pointing device as described by Kim with the characteristics of the Nishimoto's pointing device to arrive at the claimed invention. A motivation for doing so would have been to ensure the proper calibration of the pointer.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


Art Unit: 2681

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is (571) 272-779. The examiner can normally be reached on Monday-Friday 8:00AM- 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre-Louis Desir
AU 2681
11/19/2005


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER